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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,635	02/15/2002	Masayuki Inai	KOT-0039	5481

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EXAMINER

CANGIALOSI, SALVATORE A

ART UNIT PAPER NUMBER

3621

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,635

Applicant(s)

INAI ET AL.

Examiner

Salvatore Cangialosi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/15/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claims 1-33 are rejected under 35 U.S.C. § 103 as being unpatentable over Onodera et al (6700677) or Holmes et al (6119108) in view of Auerbach et al (5673316).

Regarding claim 1, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control substantially as claimed. The differences between the above and the claimed invention is the use of specific portions for copyright control, e.g. abstract. It is noted that it is believed that the copyright controls of the document are functionally equivalent to the claimed limitations. Auerbach et al (See Fig.

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2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera et al or Holmes et al because the encryption control of Auerbach et al provides a much finer level of control of an electronic document because it caters to a multiplicity of users that may not need the entire document and therefore expands the market and provides greater levels of revenue to the copyright holder. Regarding the protection limitations of claim 2, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control which is a functional equivalent of the claim limitations. Regarding the encryption limitations of claim 3, Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts which is a functional equivalent of the claim limitations. Regarding the output limitations of claim 4, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control which is a functional equivalent of the claim limitations. Regarding the display limitations of claim 5, Onodera et al (See abstract, Figs.

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1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control and display which is a functional equivalent of the claim limitations.

Regarding the printing limitations of claims 6-8, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control which is a functional equivalent of the claim limitations because the elements are conventional component of a standard printing system. Regarding the protection limitations of claims 9-20, Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts which is a functional equivalent of the claim limitations. Regarding claim 21, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control substantially as claimed. The differences between the above and the claimed invention is the use of specific portions for copyright control, e.g. abstract. It is noted that it is believed that the copyright controls of the document are functionally equivalent to the claimed limitations.

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Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera et al or Holmes et al because the encryption control of Auerbach et al provides a much finer level of control of an electronic document because it caters to a multiplicity of users that may not need the entire document and therefore expands the market and provides greater levels of revenue to the copyright holder. Regarding the system limitations of claims 22-25, Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts which is a functional equivalent of the claim limitations. Regarding claim 25, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control substantially as claimed. The differences between the above and the claimed invention is the use of specific portions for copyright control, e.g. abstract. It is noted that it is believed that the copyright controls of the document are functionally equivalent to the claimed limitations. Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera et al or

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Holmes et al because the encryption control of Auerbach et al provides a much finer level of control of an electronic document because it caters to a multiplicity of users that may not need the entire document and therefore expands the market and provides greater levels of revenue to the copyright holder. Regarding claim 26, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control substantially as claimed. The differences between the above and the claimed invention is the use of specific portions for copyright control, e.g. abstract. It is noted that it is believed that the copyright controls of the document are functionally equivalent to the claimed limitations. Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera et al or Holmes et al because the encryption control of Auerbach et al provides a much finer level of control of an electronic document because it caters to a multiplicity of users that may not need the entire document and therefore expands the market and provides greater levels of revenue to the copyright holder. Regarding the protection limitations of claims 27-29, Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of

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document parts which is a functional equivalent of the claim limitations. Regarding claim 30, Onodera et al (See abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing system including a server which protects copyright and includes encryption control substantially as claimed. The differences between the above and the claimed invention is the use of specific portions for copyright control, e.g. abstract. It is noted that it is believed that the copyright controls of the document are functionally equivalent to the claimed limitations. Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera et al or Holmes et al because the encryption control of Auerbach et al provides a much finer level of control of an electronic document because it caters to a multiplicity of users that may not need the entire document and therefore expands the market and provides greater levels of revenue to the copyright holder. Regarding the protection limitations of claims 31-33, Auerbach et al (See Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) show encryption of document parts which is a functional equivalent of the claim limitations.

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Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

3. Claims 1-33 are rejected under 35 U.S.C. . 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Certain claims (1, 21, 25, 26) contain the terms "allowed to be... allowed to be...desired abstract... allowed to be" which are not positive limitations. (See In re Collier, 158 USPQ 266) It is not clear what is being claimed. The claims require only a possibility rather than an actual limitation. What is the "difficulty of decryption " of claim 30? It is not clear what are the metes and bounds of this claim.

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number **(571) 272-6927**. The

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examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at **(571) 272-6712**.

Any response to this action should be mailed to:

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Or faxed to (703)872-9306

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